

DOCKET NO.: JANS-0026 (JAB-1499 US)
Application No.: 10/019,380
Office Action Dated: April 18, 2003

PATENT

REMARKS/ARGUMENTS

Claims 1 to 21 are pending in this application and are subject to restriction.

Amendments to the Claims

Applicants are herein amending claim 1 to add the conjunctions “and” in the listing of the substituents and an “or” in the list of Q radicals. In addition, applicants are amending claim 1 to delete the phrase “such as.” Applicants are also amending claim 15 delete the term “suitable.” Finally, applicants are amending claim 9 to rewrite it as a method of treating a viral infection, comprising the step of administering a therapeutically effective amount of a compound as claimed in any one of claims 1 to 8.

Applicants are herein adding new claim 22 directed to the process of claim 15, further comprising the step of converting said compound of formula (I'), stereochemically isomeric form, metal complex, quaternary amine or *N*-oxide form thereof, into a different form of compound of formula (I'), stereochemically isomeric form, metal complex, quaternary amine or *N*-oxide form thereof. Support for the amendment is found, *inter alia*, in original claim 15.

Applicants respectfully submit that the amendments to the claims are ministerial in nature; do not introduce new matter; and are fully supported by the specification, as originally filed.

Restriction Requirement

Restriction has been required under 35 U.S.C. §§ 121 and 372 between:

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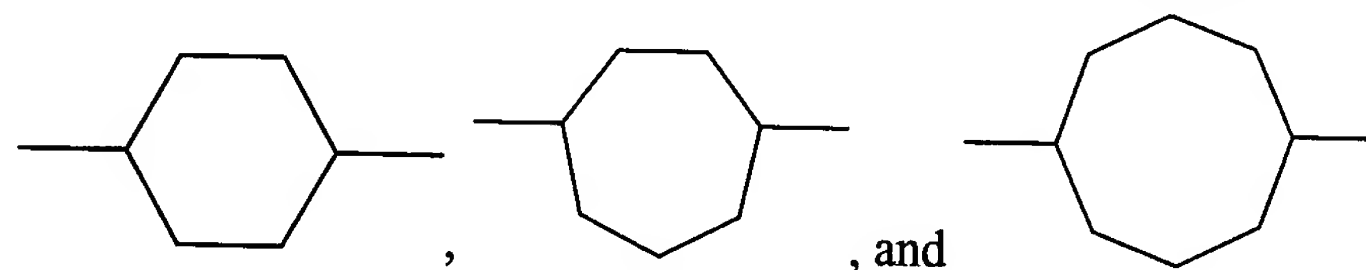
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Group	Claims	Subject Matter
I	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a monoazine ring [(a-2) to (a-5)] and where Q = 7-8 membered ring with 1-2 nitrogens (but not including alternate forms of compound)
II	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a monoazine ring [(a-2) to (a-5)] and where Q = 5-6 membered ring with 1-2 nitrogens (but not including alternate forms of compound)
III	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a monoazine ring [(a-2) to (a-5)] and where Q = non-heterocyclic ring (but not including alternate forms of compound)
IV	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a benzimidazole ring [(a-1)] and where Q = 7-8 membered ring with 1-2 nitrogens (but not including alternate forms of compound)
V	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a benzimidazole ring [(a-1)] and where Q = 5-6 membered ring with 1-2 nitrogens (but not including alternate forms of compound)
VI	Claims 1-11, 15, 18-21 – in part	Drawn to compounds of formula (I) where bivalent radical forms a benzimidazole ring [(a-2) to (a-5)] and where Q = non-heterocyclic ring (but not including alternate forms of compound)
VII	Claims 12-14	Drawn to intermediates
VIII	Claims 16-17	Drawn to complex compositions
IX	Claims 1-11, 15, 18-21 – in part)	Drawn to compounds of formula (I) in other forms, <i>e.g.</i> , quaternary amine or metal complex

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It is asserted that the inventions of Groups I to IX do not relate to a single general inventive concept under PCT Rule 13.1 allegedly because they lack the same or corresponding special technical feature. It is further asserted that the inventions of Groups VII and Groups I to VI and Group IX are related as mutually exclusive species in an intermediate-final product relationship. Finally, it is asserted that Group VII is different from the remaining groups because it contains an additional ingredient not present in the other groups. If applicants elect Group IX, a requirement has also made for an election of species. Applicants wish to note for the record (and as previously noted during a telephonic discussion between the Examiner and the undersigned attorney) that Groups I to IX do not cover all of the subject matter of applicants' claimed invention. Specifically, the groups do not cover alternatives where, for example, the compounds are non-heterocyclic rings as



because 5-, 6-, 7- and 8-membered rings of Groups I, II, IV and V are restricted to heterocyclic rings and the non-heterocyclic rings of Groups III and VI are restricted to those of radical b-1 to b-4 and the above-depicted ring structures do not fall within the description of the radicals b-1 to b-4. Furthermore, b-4 includes heterocyclic rings that are not covered by the heterocyclic rings of Groups I, II, IV and V and which are also not covered by Groups III and VI since these groups are directed towards non-heterocyclic rings.

It is alleged in the Restriction Requirement that the inventions of Groups I to IX are not related to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding technical features. Applicants respectfully traverse.

First, applicants note that no objection for lack of unity was raised during the international phase of the examination of this application. Second, applicants submit Rule 13.1 is fulfilled when there is a technical relationship among the inventions involving one or

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more of the same or corresponding special technical features (See Rule 13.2 PCT). In the present application, the compounds of the invention are respiratory syncytial virus replication inhibitors and they all possess *a monocyclic heterocycle of aryl (R^1 substituent) linked via a substituted C_{1-10} alkanediyl linker to the N_1 of an imidazoles moiety fused with a 6-membered ring* in common.

Furthermore, according to MPEP § 803, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05-§ 806.05(i)); and
- (B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) to § 806.04(i), § 808.01(a), and § 808.02).

For purposes of the initial requirement, a serious burden may be *prima facie* shown if the examiner shows separate classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. In the subject application, the claims have been restricted into nine different groups, however, *no classification information has been provided*. Thus, applicants are unable to ascertain whether the groups fall within the same or separate classifications.

While applicants do not believe that a proper requirement for restriction has been established, applicants believe that any restriction among the members of the Markush groups within the claims of Groups I to VI should only be made *provisionally*. MPEP § 803.02, which addresses restriction practice with respect to Markush-type claims, clearly sets forth that the Examiner may only require a *provisional* election of a single species prior to examination on the merits. The provisional election would be given effect in the event that the Markush-type claim was found not to be allowable. Following election, the Markush-type claim would be examined fully with respect to the elected species and further to the extent necessary to determine patentability. If the Markush-type claim were not allowable over the prior art, examination would be limited to the Markush-type claim and claims to the

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elected species, with claims drawn to species patentably distinct from the elected species held withdrawn from further consideration. However, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

The MPEP provides an example in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D, and E. With such a claim, the examiner may require a *provisional* election of a single species (CA, CB, CC, CD, or CE). The Markush-type claim is then examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If, on examination, the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species would be rejected, and claims to the non-elected species would be held withdrawn from further consideration. On the other hand, if no prior art anticipates or renders obvious the elected species, the search of the Markush-type claim would then be extended.

Thus, applicants respectfully request reconsideration of the requirement for restriction, and in particular an indication that the requirement is only a provisional election for the purpose of carrying out the search. Nonetheless, to be fully responsive to the restriction requirement, applicants elect *with traverse* to prosecute the claims of **Group V**. Furthermore, applicants wish to preserve the right to file divisional applications to the non-elected subject matter.

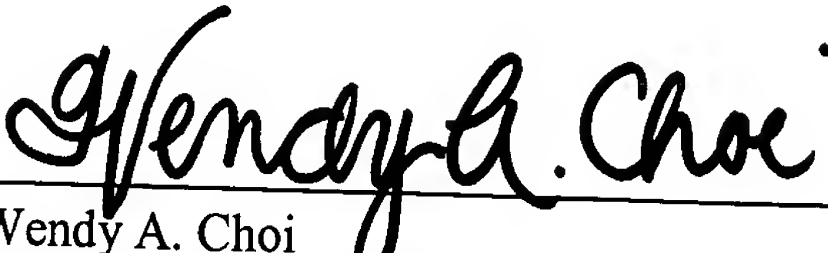
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If the Examiner is of a contrary view, the Examiner is requested to contact the undersigned attorney at (215) 557-3861.

Applicants are enclosing herewith a petition for a one-month extension of time.

Date: June 17, 2003


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